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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/615,510 | 07/07/2003 | Henrik S. Klint | 8627-227 | 9194 |

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EXAMINER

FOREMAN, JONATHAN M

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3736

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|----------------------------------------|------------|---------------|
| 3 MONTHS | 04/09/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/615,510

Applicant(s)

KLINT, HENRIK S.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/05/06/05/03/05/10/03.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 – 9, 19 and 20, drawn to a guidewire, classified in class 600, subclass 585.
 - II. Claims 10 - 18, drawn to a method of making a guidewire, classified in class 242, subclass 360.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process can be used to make electrical wire and the product can be made by first winding a plurality of individual wires, then meshing the wires together.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. During a telephone conversation with John Beaupré on 3/30/07 a provisional election was made without traverse to prosecute the invention of I, claims 1 – 9, 19 and 20. Affirmation of this

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election must be made by applicant in replying to this Office action. Claims 10 – 18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

The information disclosure statements filed 10/9/03; 3/4/05; 6/9/05 and 12/19/05 comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. They have been placed in the application file, and the information referred to therein has been considered by the examiner as to the merits. The cited U.S. Applications have been lined through because they are not patents or publications.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3 – 6 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,111,829 to Alvarez de Toledo.

In regard to claims 1, 3 – 6 and 19, Alvarez de Toledo discloses a body portion having a first diameter and comprising a multiple filament group of individual wire coils wound adjacent one another (Col. 4, lines 32 – 35); a distal end having a second diameter that is less than the first diameter; a taper portion having a taper from the first diameter to the second diameter (Figure 4); and a coating (32, 34) disposed over the distal end, taper portion and at least a part of the body portion. The coating defines a taper adjacent the taper portion. The coating comprises an elastic material, a low-friction coating and a hydrophilic material (Col. 4, lines 4 – 8).

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8. Claims 1, 3 – 6, 8, 9, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,251,085 to Tezuka.

In regard to claims 1, 3 – 6, 8, 9, 19 and 20, Tezuka discloses a body portion having a first diameter and comprising a multiple filament group of individual wire coils (Col. 6, lines 47 – 50) wound adjacent one another; a distal end having a second diameter that is less than the first diameter; a taper portion having a taper from the first diameter to the second diameter (Figure 2A); and a coating (3, 9) disposed over the distal end, taper portion and at least a part of the body portion. The coating defines a taper adjacent the taper portion. The coating comprises an elastic material, a low-friction coating and a hydrophilic material (Col. 5, lines 29 – 51). The taper includes individual wire coils having different diameters wound at pitch angle different than a pitch angle of the body portion.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,251,085 to Tezuka as applied to claim 1 above, and further in view of U.S. Patent No. 6,656,134 to Cornelius et al.

In regard to claim 2, Tezuka discloses a coating (3, 9) over the distal end, taper portion, and at least a part of the body portion, but fails to disclose the coating having a continuous diameter. Cornelius et al. disclose a guidewire having a coating over the distal end, taper portion, and at least a

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part of the body portion, wherein the coating has a continuous diameter (Figure 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the coating as disclosed by Tezuka to be continuous as taught by Cornelius et al. in order to avoid any steps or transitions onto which tissue may be caught during the advancement of the guidewire into the body.

11. Claims 1, 4 – 7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,947,940 to Beisel in view of U.S. Patent No. 5,098,374 to Othel-Jacobsen et al.

In regard to claims 1, 4 – 7 and 19, Beisel discloses a body portion having a first diameter and comprising a multiple filament group (14a, 14b, 14c) of individual wire coils wound adjacent one another; a distal end that defines a lumen and a lumen opening (Col. 7, lines 55 – 65); and a coating (12) disposed over the distal end, and at least a part of the body portion and terminates adjacent the opening. The coating comprises an elastic material, a low-friction coating and a hydrophilic material. However, Beisel fails to disclose a tapered portion tapering from a first diameter to a second diameter less than the first diameter. Othel-Jacobsen et al. disclose a catheter having a tapered portion (1) from a first diameter to a second diameter less than the first diameter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device as disclosed by Beisel to include a tapered portion from a first diameter to a second diameter less than the first diameter to increase the flexibility of the distal end of the device.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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